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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,797	07/26/2002	Achim Gopferich	02592	1932

7590 09/12/2007  
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IRVINE, CA 92618

EXAMINER
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SILVERMAN, ERIC E

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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09/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/019,797

Applicant(s)

GOPFERICH ET AL.

Examiner

Eric E. Silverman, PhD

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-32 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 16-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' response, filed 8/28/2007, has been received. Claims 1 – 6, 9 – 32 are pending, and claims 12, 13, and 16 – 32 are withdrawn from consideration as being drawn to non-elected species. Claims 1 – 6, 9 – 11, 14 and 15 are discussed on the merits in this action.

#### ***Claim Objections***

The objection to claim 11 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is **withdrawn** in view of the amendment.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 6, 9 – 11, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that the grounds for the rejection of claims 6, 10, and 11 under this statute have been overcome by amendment. However, the amendment to claim 1 raised new issues under this statute, as discussed below.

Claim 1 now recites, in pertinent part, "being at least one selected from polylactide, polyglycolide, and poly(lactide-co-glycolide)". It is not certain what is meant by the clause "being at least one" before the standard Markush language of "selected from ..."

The remaining claims are rejected for ultimately depending on claim 1 without clarifying this issue.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 6, 9 – 11, 14 and 15 **remain** rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/03356 for reasons of record and those discussed below.

Applicants' arguments are responded to below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 11 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/03356 for reasons of record and those discussed below.

Claim 11 **remains** rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/03356 in view of US 4,904,479 to Illum for reasons of record and those discussed below.

***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive. Applicants correctly point out that claim 8 was not rejected in the previous office action,

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and argued that by amendment of claim 1 to include the limitations of claim 8 and the intermediate dependant claim 7, the art rejections should be overcome.

Upon reconsideration of the prior art, the Office takes the position that the WO reference does indeed teach the subject matter of current claim 1 (including that which was previously recited in independent claims 7 and 8). Former claims 7 and 8 further limited claim 1 by requiring that the hydrophobic biodegradable polymer (a) be selected from polylactide, polyglycolide and poly(lactide-co-glycolide) and that the hydrophilic polymer comprise polyethylene glycol. Turning to Example 15 in the WO reference, a multiblock copolymer which includes blocks of PLA (hydrophobic polymer (a)) and multiple blocks of PEG (hydrophilic polymer (b)). Figure 2f, compound K also depicts a polymer with these properties. Thus, since the limitations of (former) claims 7 and 8, now incorporated into claim 1, are met by the prior art, the amendment does not overcome the art rejections.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone °

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 1615

  
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